

Application No. 10/582,481

Docket No. R2184.0506/P584

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REMARKS

Claims 1, 6 and 8 have been amended. New claims 31-33 have been added. Limitations added to the claims find support in the original disclosure, including Fig. 9, and support for the new claims appears, for example, in Fig. 11. The application now contains claims 1, 2, 4, 6-9, 11, 14 and 31-33. Applicants reserve the right to pursue the original claims and other claims in this and other applications.

Claims 1, 2, 4, 6, 8, 9 and 11 are rejected under 35 U.S.C. § 103 as being unpatentable over Narumi in view of Spruit, and as being unpatentable over Narumi in view of Kubo and further in view of Van Der Vleuten. Reconsideration is respectfully requested. The Office Action relies on Narumi as allegedly disclosing the "first region of the first test writing area . . . completely superposed with a second region of the second writing area," as was recited in claim 1 before the claim was amended. Specifically, the Office Action relies on the first test recording area 826 and the second test recording area 836 of Narumi as alleged disclosure of the recited first and second test writing areas, respectively. Please note, however, as shown in Fig. 8, the first and second test recording areas 826, 836 of Narumi merely overlap in part; they are not superposed completely. The first test recording area 826 (alleged first test writing area) is not completely superposed with the second test recording area 836 (alleged second test writing area). This is an important difference between Narumi and the claimed invention.

The Office Action does not rely on Spruit, Kubo or Van Der Vleuten to compensate for the deficiency of Narumi. Nor do Spruit, Kubo, or Van Der Vleuten compensate for the deficiency. Thus, the above-noted feature of claim 1, as now recited in the amended claim as follows: "the first test writing area is completely superposed with the second test writing area when considered in the direction in which the laser is arranged to irradiate," should justify withdrawal of the § 103 rejections with respect to claim 1.

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Among other things, a *prima facie* case of obviousness must establish that the asserted combination of references teaches or suggests each and every element of the claimed invention. In view of the distinction of claim 1, as amended, noted above, at least one claimed element is not present in the asserted combination of references. Hence, the Office Action fails to establish a *prima facie* case of obviousness vis-à-vis claim 1. For similar reasons, the Office Action fails to establish a *prima facie* case of obviousness vis-à-vis claims 6 and 8 as amended. Claims 2, 4, 7, 9, 11 and 14 ultimately depend from claims 1, 6 and/or 8, and so at least for similar reasons those claims should be allowable over the asserted combination of references.

New claims 31-33 should be allowable over the prior art for reasons similar to those discussed above in connection with claim 1, and for other reasons. Accordingly, allowance of the application with claims 1, 2, 4, 6, 8, 9, 11, 14 and 31-33 is solicited.

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Respectfully submitted,

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